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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,859	12/09/2003	Anand R. Baichwal	540.1020c3	6846
23280	7590	10/02/2006		
DAVIDSON, DAVIDSON & KAPPEL, LLC			EXAMINER	
485 SEVENTH AVENUE, 14TH FLOOR			ROGERS, JAMES WILLIAM	
NEW YORK, NY 10018			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/731,859	BAICHWAL, ANAND R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James W. Rogers, Ph.D.	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

The Amendment filed 08/23/2006 has been entered. Any previous rejection from the office action dated 04/19/2006 not addressed below has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baichwal (EP 0582,676 A2), this new rejection was necessitated by amendment.

Baichwal discloses a controlled release formulation and the method to make the formulation which can be in the form of a tablet and includes a therapeutically active medicament such as ibuprofen, a heterodisperse gum matrix comprised of xantham gum and locust beam in a ratio of about 1:3 to about 3:1 and an inert filler in a ratio to the deterodisperse gum matrix of about 3:7 to about 7:3. See abstract, pag lin 39-55, pag 4 lin 29-50, pag 5 lin 23-31, pag 7 lin 23-38 and examples. Regarding claims 1,10,18-19,21,24 and 27 the amount of NSAID or ibuprofen in mg or as a ratio to the combined weight of xantham and locust bean gum is met because Baichwal discloses "the ratio of medicament to the heterodisperse polysaccharide is based in part upon the relatively solubility of the medicament and the desired rate of release, also Baicwal discloses that "a computer aided pharmacokinetic model can be used to predict likely in

vivo drug blood levels from condition-independent in-vitro drug profiles", therefore it is obvious that one of ordinary skill in the pharmaceutical art will vary the amount of active ingredients depending on its intended use and desired blood levels. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). Regarding claims 1,10 and 18 the dissolution as measured by a USP Type II (Paddle) Method limitation is met because the claimed tablet compositions encompass the same scope it would be obvious that their dissolution properties would be the same since the same composition would have the same properties including dissolution profiles.

Claims 1-17 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baichwal (EP 0582,676 A2) in view of Kuhrt (US patent 5,096,714), this new rejection was necessitated by amendment.

The Baichwal patent is described as above.

The Baichwal patent does not specifically mention the exact amount of active ingredient in mg.

The Kuhrt's patent describes a sustained release dosage tablet comprising up to 700 mg of ibuprofen (reads on about 800 mg in claim 21) and an effective amount of sustained release carrier, in an amount effective to provide prolonged and effective release of the drug. See claim 1 and ex 10.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Baicwal teaches all of the claimed invention in applicants claims except specifically mentioning the amount of active ingredient in mg while the Kuhrt's patent discloses the use of ibuprofen within the range claimed by applicants in a slow release tablet. The motivation to combine the two documents would be the formulation of a pharmaceutical tablet formulation with the following ingredients ibuprofen, xanthan gum with the cross-linking agent locust bean gum and an inert diluent. The advantage of such a tablet formulation would be the ability to maintain a desired blood level of a medicament over a comparatively longer period of time while reducing the number of administrations necessary to achieve the same. Thus, the claimed invention, taken as a whole was *prima facie* obvious over the combined teachings of the prior art.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baichwal (EP 0,582,676 A2, '676 from hereon) in view of Kuhrt's (US patent 5,096,714) and in view of Baichwal (EP 0,642,785 A2, '785 from hereon), this new rejection was necessitated by amendment.

'676 is disclosed above. '676' does not disclose the amount of active ingredient in mg nor does the patent disclose a hydrophobic coating wherein about 1-20 % ibuprofen is coated on the tablet.

Kuhrts is disclosed above.

'785 is used primarily for its disclosure that a sustained release pharmaceutical formulation comprised of a therapeutic, xantham and locust bean gum coated by a hydrophobic polymer, the coating can further contain 10-40 % of the therapeutic in its outer layer. See pag 8 lin 1-11 and claims.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because '676 discloses all of the claimed invention in applicants claims except specifically mentioning the amount of active ingredient in mg and a hydrophobic coating wherein about 1-20 % ibuprofen is coated on the tablet while the Kuhrts patent discloses the use of ibuprofen within the range claimed by applicants and '785 discloses a hydrophobic coating that can comprise 10-40 % of an active ingredient in its outer layer. The motivation to combine the two documents would be the formulation of a pharmaceutical tablet formulation with a core comprised of ibuprofen, xanthan gum, locust bean gum an inert diluent and a hydrophobic coating that also contains ibuprofen. The advantage of such a tablet formulation would be the ability to maintain a desired blood level of a medicament over a comparatively longer period of time while reducing the number of administrations necessary to achieve the same. Thus, the claimed

invention, taken as a whole was *prima facie* obvious over the combined teachings of the prior art.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21, 22-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,093,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-28 are generic to all that is recited in claims 1-46 of U.S. Patent No. 6,093,420. That is, claims 1-46 of U.S. Patent No. 6,093,420 falls entirely within the scope of claims 1-26 or in other words, claims 1-26 are anticipated by claims 1-46 of U.S. Patent No. 6,093,420. Specifically both claim a tablet comprising ibuprofen, xanthan gum, locust bean gum and an inert diluent, in which both dissolve at the same rate when measured by a USP Type II (Paddle) Method. Also both claim mostly the same concentrations, ratios and percentages or at least they are within the ranges specified for the above ingredients.

### ***Conclusion***

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (572) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (572) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER